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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,198	10/02/2000	Michael J. Natan	PSU 00 2182B	7112

25871 7590 09/22/2003

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EXAMINER

MARSCHIEL, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 09/22/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/677,198

Applicant(s)

NATAN ET AL.

Examiner

Ardin Marschel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003 and 07 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37,39-47,55-64 and 87-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37,39-47,55-64 and 87-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Applicants' arguments, filed 5/5/03 and 7/7/03, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

PRIOR ART

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37, 39-47, 55-64, and 87-104 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kaye et al. [Ref. AS: WO 97/15390 (1997)].

This rejection is maintained and reiterated from the previous office action, mailed 1/3/03, and necessitated by amendment regarding newly added claims. Applicants argue that the particles in Kaye et al. all have the same sequence of layers and therefore cannot be differentiated by segment sequence. In response consideration of instant claim 37 has revealed that the segments cited in said claim are generic and broadly worded such that they are not limited to layers of differing materials. Thus, segments made up of differing shapes in one material are reasonably interpreted also as segments within the interpretation of the instant claims. It is additionally noted that applicants have not pointed in arguments to any specific definition that limits the above

broad interpretation of what is meant by "segments", nor has consideration of the entirety of the instant disclosure as filed. Specifically, on page 4, lines 8-13, a sentence in the specification defines "segments" (plural) as comprising any material (singular). A listing of material follows only one option in the list being a composite of materials for the segments (plural). Also, in the specification, as filed, on page 10, lines 24-26, the segments being of the same material is clearly set forth. Therefore, segments corresponding to the machine-readable code on one phase of the Kaye et al. particles are reasonable interpreted as segments as instantly claimed. The layers of Kaye et al., as argued by applicants, are differing material layers wherein the two layers, called phases, make up the solid support and the phase containing a machine-readable code. This is acknowledged, however, given the above broad interpretation of segments, the segments within the machine-readable code layer still are deemed to anticipate this limitation of the instant invention. Applicants' arguments are therefore non-persuasive.

Applicants then argue that none of the particles disclosed in Kaye et al. are rod shaped. This argument is confusing and non-persuasive because the very front page of Kaye et al. shows a clearly rod shaped particle as the bottom two particles. Applicants then go on to summarize non-symmetric particle features but no further particular argument has been discerned in the latter part of the remarks directed to the Kaye et al. reference and therefore nothing persuasive is set forth therein.

Regarding newly added claims 87-104 the first set of claims set forth as claims 87-95 contain limitations that are already within claims 37, 39-47, and 55-64 and are therefore rejected as summarized above. Claims 96-104 add the limitation of striping

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which does not distinguish the claimed invention over Kaye et al. particles whereon machine-readable code is present as stripes as code segments. Again the very front page of the reference shows line shaped stripes as segments as instantly claimed. No distinguishing limitation has been argued or set forth that distinguishes the instant stripes from those of Kaye et al. coding lines.

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

September 17, 2003

